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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,500	09/26/2003	Erwin Behnen	ROC920030119US1	3743

7590

09/06/2005

Intellectual Property Law Dept.
IBM Corporation, Dept. 917
3605 Highway 52 North
Rochester, MN 55901-7829

EXAMINER

DINH, PAUL

ART UNIT

PAPER NUMBER

2825

DATE MAILED: 09/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/672,500

Applicant(s)

BEHNEN ET AL.

Examiner

Paul Dinh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,18 and 20-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1,2,18 and 20-31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is a response to the amendment with RCE filed on 8/8/05. Claims 1-2, 18, and 20-31 are pending.

This application is in condition for allowance except for the following formal matters:

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o).

The limitation “*subset*” in claims finds no support in the specification.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims.

Claim 24 recites “a timing verification tool”; therefore, the timing verification tool must be clearly shown/labeled in the drawings or this feature canceled from the claims.

NO NEW MATTER SHOULD BE ENTERED

Claim Objections

Claims 1, 18, and 24 are objected to because:

- a. The preambles of these claims must recite purpose/intended use/application.
- b. “the timing behavior” in claims 1 and 24 lacks antecedent basis.
- b. “non-transparent” and “transparent” should be clearly defined in claims 1, 18, and 24.
- c. “timing tool models each latch of the circuit design as being non-transparent” is an incomplete claim structure. Claims 1, 18, and 24 should define how/by doing what and steps/structure necessary to make each latch being “non-transparent”
- d. “subset” is not clearly described in the specification and not clearly defined in 1, 18, and 24; “subset” must be both clarified and clearly defined in claims 1, 18, and 24.
- e. “allow a subset of one or more latches of the circuit design exhibit latch transparency” in claims 1 and 18 is an incomplete claim structure. Claims 1 and 18 should define how/by doing what and

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steps/structure necessary to allow a subset of one or more latches of the circuit design exhibit latch transparency.

- e. “while still being modeled” in claims 1 and 18 is not clear as to what still being modeled.

Claims 1 and 18 must recite what still being modeled.

- f. “input” in claim 24 should be defined, i.e. clock input.

g. “allowing a selected subset of one or more latches of the circuit design to exhibit latch transparency while still being modeled as non-transparent by the timing tool/timing verification tool” in claims 1, 18, and 24 is unclear as to how two opposite operations “latch transparency while still being modeled as non-transparent by the timing tool/timing verification tool” can be obtained simultaneously; claims 1, 18, and 24 must define how/by doing what and steps/structure necessary to achieve this result of exhibit latch transparency while still being modeled as non-transparent by the timing tool/timing verification tool.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

NO NEW MATTER SHOULD BE ENTERED.

CORRECTION IS REQUIRED.

Reasons for Allowance

Claims 1-2, 18, and 20-31 are would be allowable because the prior art does not teach or suggest a method/product in the manner as recited in the claims.

Conclusion

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter

Any inquiry concerning this communication from the examiner should be directed to Paul Dinh whose telephone number is 571-272-1890. The examiner can normally be reached on Monday to Friday from 8:30am to 5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Smith can be reached on 571-272-1907. The fax number for the organization handling this application is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul Dinh
Patent Examiner

A handwritten signature in black ink that reads "Paul Dinh". The signature is written in a cursive style with a long, sweeping underline that extends to the right.